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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,786	07/16/2002	Klaus Ulrich Klosa	FREI.P-052	9616
57380 7590 05/02/2007 Oppedahl Patent Law Firm LLC P.O. BOX 4850 FRISCO, CO 80443-4850			EXAMINER FIELDS, COURTNEY D	
			ART UNIT 2137	PAPER NUMBER
			NOTIFICATION DATE 05/02/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket-oppedahl@oppedahl.com

Office Action Summary

Application No.

10/070,786

Applicant(s)

KLOSA ET AL.

Examiner

Courtney D. Fields

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-53, 57 and 58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29, 31, 32, 42-45, 48, 57 and 58 is/are rejected.
- 7) ☒ Claim(s) 38-40 and 50-52 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Claims 54-56 have been cancelled.
2. Claims 29 and 57-58 have been amended.
3. Claims 29-53 and 57-58 are pending.

Response to Arguments

4. Applicant's arguments filed 19 February 2007 have been fully considered but they are not persuasive.
5. Referring to the rejection of claim 29, 57, and 58, the Applicant contends that the prior art (Eberhand) nor (Sciupac) disclose an initialization process and especially not a method for initialization of decentralized read and write stations (WR, A-WR) and data carriers (IM) from a remote authorization or means for authorization. The Examiner respectfully disagrees and asserts that Eberhand discloses an initialization of decentralized read and write stations by generating a random number and transmitting it to a mobile data carrier. The mobile data carrier receives the random number and generates and transmits a second random number. The mobile data carrier and the read and write station encrypt the random numbers with a secret key. The remote authentication is performed by mobile data carrier's cryptogram comparing it to the read and write station's cryptogram. If a match is not made, the first bits of the authentication will not match. If a match is made, the remote authentication between the mobile data carrier and the read and write station is successful. (See Column 3, lines 45-67 and Column 4, lines 1-9)

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6. Referring to the rejection of claims 29,57, and 58, the Applicant contends that the prior art (Eberhand) does not disclose an authorization authority. The Examiner disagrees and asserts that in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As shown in the previous office action, the Examiner rejects the claimed limitation as being unpatentable over Eberhand in view of Sciupac.
7. Therefore, the rejection of claims 29-53 and 57-58 are maintained in view of the reasons above and in view of the reasons below.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 29,31-32,42-45, 48, and 57-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Eberhand (US Patent No. 5,473,689).

Referring to the rejection of claims 29,57,and 58, Eberhand discloses a method, mobile data carrier, and a read and write station wherein initialization data are generated in an authorization process in a secure environment at a remote authorization authority by means of authorization means (See Column 3, lines 45-67 and Column 4, lines 1-9)

and the initialization data are sent over a network in a secure communication according to security rules corresponding to the authorization system to an authorized read and write station (See Column 3, lines 3-23)

where the mobile data carriers are initialized with the initialization data and/or that the initialization data are over the network to a read and write station by means of which the read and write station is initialized (See Column 3, lines 24-36)

Referring to the rejection of claims 31 and 48, Eberhand discloses the claimed limitation wherein the authorization means are consisting of special authorization identification media or authorization data (See Column 3, lines 37-41)

Referring to the rejection of claim 32, Eberhand discloses the claimed limitation wherein a non-authorized decentralized read and write station at first transformed into an authorized read and write station by means of function authorization data which are contained in the initialization data, and which is capable of initializing mobile data carriers (See Column 4, lines 3-9)

Referring to the rejection of claim 43,44, and 45, Eberhand discloses the claimed limitation wherein initialization a user authorization or personal data is effected by the read and write station or by its owner an identification authorization means is required (See Column 3, lines 45-67, Column 4, lines 1-2)

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 30,33-37,41-42, 46-47,49, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eberhand (US Patent No. 5,473,689) in view of Sciupac (US Patent No. 6,871,278).

Referring to the rejection of claim 30, Eberhand discloses everything claimed as applied to claim 29, however Eberhand fails to explicitly disclose an authorization authority formed by a host computer or by a read and write station. Sciupac discloses the claimed limitation wherein the authorization authority is formed by a host computer or by an authorization read and write station (See Column 4, lines 4-12)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Eberhand's method for authenticating mobile data carriers with Sciupac's passive storage media system, such as optical memory cards. Motivation for such an implementation would enable both hardware and software/firmware security measures to deny unauthorized access to cryptographic keys and to prevent interception of decrypted data streams (See Column 2, lines 21-28)

Referring to the rejection of claims 33-34, Eberhand discloses everything claimed as applied to claim 29, however Eberhand fails to explicitly disclose authorization authorities with the same or different levels. Sciupac discloses the claimed limitation wherein within the framework of the authorization system several authorization authorities with the same and/or with differing levels are provided (See Column 4, lines 29-45)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Eberhand's method for authenticating mobile data carriers with Sciupac's passive storage media system, such as optical memory cards. Motivation for such an implementation would enable both hardware and software/firmware security measures to deny unauthorized access to cryptographic keys and to prevent interception of decrypted data streams (See Column 2, lines 21-28)

Referring to the rejection of claims 35, 49, and 53, Eberhand discloses everything claimed as applied to claim 29, however Eberhand fails to explicitly disclose initialization data sent to the decentralized read and write stations through more than one network level and/or through more than one authorization authority. Sciupac discloses the claimed limitation wherein initialization data are sent to the read and write stations or to the decentralized read and write stations through more than one network level and/or through more than one authorization authority (See Column 4, lines 4-12)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Eberhand's method for authenticating mobile data carriers with Sciupac's passive storage media system, such as optical memory cards. Motivation for such an implementation would enable both hardware and software/firmware security measures to deny unauthorized access to cryptographic keys and to prevent interception of decrypted data streams (See Column 2, lines 21-28)

Referring to the rejection of claims 36 and 41, Eberhand discloses everything claimed as applied to claim 29, however Eberhand fails to explicitly disclose a secure

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private network. Sciupac discloses the claimed limitation wherein the initialization data are sent over a secure private network (See Column 6, lines 27-35)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Eberhand's method for authenticating mobile data carriers with Sciupac's passive storage media system, such as optical memory cards. Motivation for such an implementation would enable both hardware and software/firmware security measures to deny unauthorized access to cryptographic keys and to prevent interception of decrypted data streams (See Column 2, lines 21-28)

Referring to the rejection of claims 37 and 42, Eberhand discloses everything claimed as applied to claim 29, however Eberhand fails to explicitly disclose a public network with encryption. Sciupac discloses the claimed limitation wherein the initialization data are sent over an open public network with an encryption and security gates on both sides (See Column 6, lines 45-58)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Eberhand's method for authenticating mobile data carriers with Sciupac's passive storage media system, such as optical memory cards. Motivation for such an implementation would enable both hardware and software/firmware security measures to deny unauthorized access to cryptographic keys and to prevent interception of decrypted data streams (See Column 2, lines 21-28)

Referring to the rejection of claim 46, Eberhand discloses everything claimed as applied to claim 29, however Eberhand fails to explicitly disclose an application micro-processor. Sciupac discloses the claimed limitation wherein the mobile data carriers

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comprise an application micro-processor for the processing of application program data
(See Column 3, lines 20-33)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Eberhand's method for authenticating mobile data carriers with Sciupac's passive storage media system, such as optical memory cards. Motivation for such an implementation would enable both hardware and software/firmware security measures to deny unauthorized access to cryptographic keys and to prevent interception of decrypted data streams (See Column 2, lines 21-28)

Referring to the rejection of claim 47, Eberhand discloses everything claimed as applied to claim 29, however Eberhand fails to explicitly disclose contact-less, active or passive identification media. Sciupac discloses the claimed limitation wherein the data carriers are designed as contact-less, active or passive identification media (See Column 4, lines 57-67, Column 5, lines 1-42)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Eberhand's method for authenticating mobile data carriers with Sciupac's passive storage media system, such as optical memory cards. Motivation for such an implementation would enable both hardware and software/firmware security measures to deny unauthorized access to cryptographic keys and to prevent interception of decrypted data streams (See Column 2, lines 21-28)

Allowable Subject Matter

12. Claims 38-40, 50-52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Courtney D. Fields whose telephone number is 571-272-3871. The examiner can normally be reached on Mon - Thurs. 6:00 - 4:00 pm; off every Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



cdf

April 26, 2007



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SUPERVISORY PATENT EXAMINER